



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTORNEY DOCKET NO. AUS000060US1

In re Application of:

RABINDRANATH DUTTA

Serial No.: 09/535,559

Filed: March 27, 2000

For: **THIRD PARTY CONTRACT
DEPOSITORY FOR E-COMMERCE
TRANSACTIONS**

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Examiner: **RUDY, ANDREW J.**

Art Unit: 3627

APPEAL BRIEF

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Sir:

This Appeal Brief is submitted in triplicate in support of an Appeal of the Examiner's final rejection of Claims 5-7, 11-14, 19 and 20 in the above-identified application. A Notice of Appeal was filed in this case on October 8, 2003 and received in the Patent Office on October 14, 2003. Please charge the fee of \$330.00 due under 37 C.F.R. § 1.17(c) for filing the brief, as well as any additional required fees, to **IBM DEPOSIT ACCOUNT NO. 09-0447**.

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REAL PARTY IN INTEREST

As evidenced by the Assignment set forth at Reel 010712, Frame 0812, the present application is assigned to International Business Machines Corporation, the real party in interest of the present Appeal.

RELATED APPEALS AND INTERFERENCES

An Appeal of co-pending and related U.S. Patent Application, No. 09/534,595, which Appeal was filed on December 15, 2003, directly affects or would be directly affected by or have a bearing on the Board's decision in the present Appeal. There are no other Appeals or Interferences known to Appellants, the Appellants' legal representative, or assignee, which would be directly affected or have a bearing on the Board's decision in the present Appeal.

STATUS OF CLAIMS

Claims 5-7, 11-14, 19 and 20 stand finally rejected by the Examiner as noted in the Advisory Action dated **September 5, 2003**.

STATUS OF AMENDMENTS

No amendments to the claims have been made subsequent to the final rejection that leads to this Appeal.

SUMMARY OF THE INVENTION

As described by the specification, Appellants' invention provides a system and method for insuring the integrity of electronic documents generated during an e-commerce transaction between a first and second party. Specifically, the invention provides an electronic depository (third component) service by which e-commerce generated documents are stored. The E-directory is a WORM (write-once read-many) storage that prevents subsequent changes to the transaction document, once created.

Page 13, lines 23-31 of the specification, provides a description of an e-commerce transaction between a buyer (1st party) and a seller (2nd party) that generates a contract (e-document) that is "deposited in a third party depository." (*see also* page 14, lines 4-5, and page

15, lines 2-5, which describes a “third party” depository). At page 14, lines 11-23, additional functionality of the depository are provided, including having the E-commerce server subscribe to the independent depository service so that all generated e-commerce transaction documents are automatically transmitted to and stored at the depository.

As recited within exemplary Claim 5, Appellants’ invention provides: “an electronic database” that includes means for (1) “automatically receiving an electronic document dynamically generated ...during an E-commerce transaction”, (2) “generating a document identifier (ID)”, and (3) “transmitting the document ID to each party to the E-commerce transaction that produced the electronic document.”

ISSUES

The primary issue for appeal is whether Claims 5-7, 11-14, 19 and 20 are unpatentable under 35 U.S.C. § 103(a) over Roderick (U.S. Patent No. 6,122,648). Resolution of that issue, however, depends on a determination whether the reference suggests to one skilled in the art a third part (or independent) electronic depository that completes the three features of receiving a generated e-commerce document, generating a corresponding document ID, and providing the ID to the two parties to the transaction to enable later access to the document on the depository, as is recited by exemplary Claim 5.

GROUPING OF THE CLAIMS

For purposes of this Appeal claims 5-7, 11-14, 19 and 20 stand or fall together as a single group.

ARGUMENT

The present Appeal is filed in response to the Examiner’s Final Action dated May 8, 2003 in which Claims 5-7, 11-14, 19 and 20 were rejected under 35 U.S.C. § 103(a), as being unpatentable over Roderick (U.S. Patent No. 6,122,648). That rejection is not well founded and should be reversed.

The features recited by exemplary Claim 5 are provided above. Appellants respectfully submit that Roderick does not render the present invention obvious because Roderick fails to suggest to one skilled in the art the listed features of exemplary Claim 5.

Examiner provides very little discussion of what is taught by Roderick. However, Appellants have reviewed the entire reference and found Roderick to be devoid of any teaching of a third party depository, storing e-commerce generated documents at a depository, or assigning a document ID that is sent to the first and second party to the transaction to enable either party future access to the document.

At page 3 of the Final Action, Examiner points to col. 4, lines 20+ of Roderick as disclosing the generation of the document ID and means for receiving an electronic document and “transmitting the document to each client associated with each e-commerce transaction.” The latter feature is not recited within Appellants’ claims, although Appellants do allow for the document to be viewed at the depository during some future access.

With respect to the first feature, Appellants have found no support for Examiner’s assertion. The cited section of Roderick states an “industry standard product identifier” (col. 4, lines 33-35) is provided by the user to imitate a search. At lines 54-65, Roderick provides a comprehensive description of his inventive features, i.e., “upon receiving... an industry standard product identifier... search for and retrieve ... information..., and generates executable instructions to create the requested information page...” The retrieved information is utilized to create an information page for the information. However, the information page is sent/returned to the user. The information page is neither stored nor given a unique ID that would identify that specific user-initiated search that resulted in the generation of the information page.

Use of an “industry standard product identifier” to retrieve a document from a database is in no way suggestive of the features provided by Appellant’s exemplary Claim 5. Roderick provides more of a search engine functionality, where the user enters the search term (industry standard product identifier) and receives search results displayed within a page.

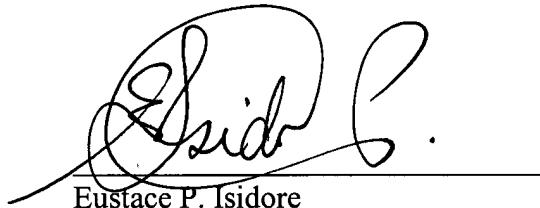
Additionally, Roderick further describes his storage medium as storage for executable instructions (**NOT a depository for created e-commerce documents**) which implement an information server (**NOT a second party to an e-commerce transaction**) for “identifying, managing and delivering information content” (col. 2, line 26) from databases over a data network. The process described by Roderick is not technically related to an e-commerce transaction that generates a unique transaction document, as those terms (e-commerce and transaction document) are understood by those skilled in the art (and as described by Appellant’s invention).

It is clear that Roderick fails to suggest the key features of Appellants’ invention. Appellants have provided arguments indicating why the Examiner has not established prima facie obviousness of the present invention. Thus, the Appellants believe that exemplary Claim 5 and all other pending claims are not rendered unpatentable by the cited reference and should be allowed.

CONCLUSION

Appellants have pointed out with specificity the manifest error in the Examiner's rejections, and the claim language, which renders the invention patentable over the reference. Appellants, therefore, respectfully request that this case be remanded to the Examiner with instructions to issue a Notice of Allowance for all pending claims.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "E. Isidore", is written over a horizontal line.

Eustace P. Isidore

Registered with Limited Recognition (see attached)

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APPENDIX

1-4. (canceled)

5. (previously presented) An electronic database used as a depository for electronic documents generated during E-commerce transactions, comprising:

means for automatically receiving an electronic document dynamically generated from information provided during an E-commerce transaction that has completed;

means for generating a document identifier (ID) for said received E-commerce generated electronic document;

means for storing said E-commerce generated electronic document with said document ID; and

means for transmitting said document ID to each party to said E-commerce transaction that produced said electronic document.

6. (canceled)

7. (previously presented) The electronic database of Claim 5, wherein said means for storing further comprises:

means for allowing a later read access to said E-commerce generated electronic document by a party to said E-commerce transaction; and

means for preventing modifications to said E-commerce generated electronic document after said document has been stored.

8-10. (canceled)

11. (previously presented) A depository for ensuring authenticity of electronic documents generated during E-commerce transactions, said depository comprising:

means for enabling automatic receipt of an electronic document that is dynamically generated in response to a completion of an E-commerce transaction in which information utilized to generate said electronic document is provided;

means for generating a document identifier (ID) to identify said E-commerce generated electronic document; and

means for storing said E-commerce generated electronic document in said depository along with said document ID that is utilized to reference and retrieve said electronic document from said depository.

12. (original) The depository of Claim 11, wherein said storing means includes:

means for limiting a write access of said electronic document to a first access; and

means for restricting subsequent access to said electronic document to read-only access, such that no changes may be made to said electronic document once it has been stored.

13. (previously presented) The depository of Claim 11, further including:

means for controlling a read and write access to said electronic depository, wherein said electronic document is stored in a write-once, read-many format;

means for providing said document ID to each party of the E-commerce transaction; and

means for later retrieving said electronic document for read access by a party to said E-commerce transaction utilizing said document ID.

14. (previously presented) The depository of Claim 13 wherein said controlling means further includes:

means for enabling a non-modification function for said electronic document, wherein a control code of said electronic depository is activated to prevent later modification to said electronic document; and

means for flagging each E-commerce generated electronic document stored within said electronic depository to allow only a later read access to said E-commerce generated electronic document by a party to said E-commerce transaction.

15-18. (canceled)

19. (previously presented) The electronic database of Claim 5, further comprising:

means for connecting said electronic database to a server at which said E-commerce transactions are conducted; and

means for enabling communication between said server and said electronic database via said connecting means.

20. (previously presented) The depository of Claim 11, further comprising:

means for connecting said depository to a server at which said E-commerce transactions are conducted; and

means for enabling communication between said server and said depository via said connecting means.

**BEFORE THE OFFICE OF ENROLLMENT AND DISCIPLINE
UNITED STATE PATENT AND TRADEMARK OFFICE**

LIMITED RECOGNITION UNDER 37 CFR § 10.9(b)

Eustace P. Isidore is hereby given limited recognition under 37 CFR §10.9(b) as an employee of Bracewell & Patterson, LLP to prepare and prosecute patent applications and to represent applicants wherein the patent applicants are clients of Bracewell & Patterson, LLP, and the attorney or agent of record in the applications is a registered practitioner who is a member of Bracewell & Patterson, LLP. This limited recognition shall expire on the date appearing below, or when whichever of the following events first occurs prior to the date appearing below: (i) Eustace P. Isidore ceases to lawfully reside in the United States, (ii) Eustace P. Isidore's employment with Bracewell & Patterson, LLP ceases or is terminated, or (iii) Eustace P. Isidore ceases to remain or reside in the United States on an H-1B visa.

This document constitutes proof of such recognition. The original of this document is on file in the Office of Enrollment and Discipline of the U.S. Patent and Trademark Office.

Expires: May 8, 2004



**Harry Moatz,
Director of Enrollment and Discipline**